



48th Floor | 333 South Hope Street | Los Angeles, CA 90071-1448
213-620-1780 office | 213-620-1398 fax | www.sheppardmullin.com

FACSIMILE COVER SHEET**** THIS FACSIMILE TRANSMISSION WILL NOT BE MAILED ****

RECEIVED
CENTRAL FAX CENTER
SEP 20 2004

Date: September 20, 2004File Number: 0EKM-106840Total number of pages:
(including 1-page cover sheet)4If all pages are not received, please call
Sheppard Mullin at 213-620-1780, ext. 2155**TO:**

U.S. Patent and Trademark Office

Facsimile No.

(703) 872-9306

Telephone No.From: Brian D. Martin, EsquireDirect Dial: 213-617-5415Re: Transmittal of Response to Restriction Requirement*Jedso 12:05 p.m.***MESSAGE:** Please see attached.**Certificate of Transmission under 37 CFR 1.8**

I hereby certify that this correspondence is being facsimile transmitted
to the United States Patent and Trademark Office on September 20, 2004.

Brian D. Martin
Brian D. Martin, Esquire

Response to Restriction RequirementApplicants: Kelvin Tsugio Okamoto et al.Title: GOLF BALLS INCORPORATING PEPTIZERS AND
METHOD OF MANUFACTURESerial No: 10/662,626Filed: September 15, 2003Examiner: Racann GordonGroup Art Unit: 3711Our Docket No.: 0EKM-106840Date Faxed: 09/20/04Client: Taylor MadeDate Due: 10/01/04Atty/Sec.: Martin/Kemp

NOTE: THIS MESSAGE IS INTENDED ONLY FOR THE USE OF THE INDIVIDUAL OR ENTITY TO WHICH IT IS ADDRESSED, AND MAY CONTAIN INFORMATION THAT IS PRIVILEGED, CONFIDENTIAL AND EXEMPT FROM DISCLOSURE UNDER APPLICABLE LAW. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT, OR THE EMPLOYEE OR AGENT RESPONSIBLE FOR DELIVERING THE MESSAGE TO THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, DISTRIBUTION OR COPYING OF THIS COMMUNICATION IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, PLEASE NOTIFY US IMMEDIATELY BY TELEPHONE AND RETURN THE ORIGINAL MESSAGE TO US AT THE ABOVE ADDRESS VIA THE U.S. POSTAL SERVICE. THANK YOU.

W02-LA:1BDM1\70681411.2

PATENT
0EKM-106840

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/662,626 Confirmation No. 9769
Applicants : Kelvin Tsugio Okamoto et al.
Filed : September 15, 2003
TC/A.U. : 3711
Examiner : Raeann Gordon

Docket No. : 0EKM-106840
Customer No. : 30764

RECEIVED
CENTRAL FAX CENTER
SEP 20 2004

September 20, 2004

VIA FACSIMILE

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Non-Final Office Action mailed September 1, 2004. On page 2 of the Office Action, the Examiner required a restriction to one of the following inventions:

- "I. Claims 1-[43], drawn to a golf ball [including a composition] . . . ;
- II. Claims [44]-50, drawn to a method [for manufacturing a golf ball] . . ."

In the Office Action, it appears that the Examiner mistakenly included claim 44 in Group I instead of Group II.

In response to the restriction requirement, Applicants elect the invention of Group I, drawn to a golf ball including a composition, with traverse. In the restriction requirement, the Examiner alleges that the application includes two distinct inventions. Specifically, the Examiner identifies Group I, claims 1-43, which are drawn to a golf ball

W02-LA:1BDM1\70752370.3
09/20/04

-1-

0EKM-106840

Appl. No. 10/662,626
Response dated September 20, 2004
Reply to Office Action of September 1, 2004

including a composition, as allegedly distinct from Group II, claims 44-50, drawn to a method for manufacturing a golf ball. The Examiner alleges that the golf ball including a composition of Group I can be made using a process that is materially different from that claimed in claim 44. Applicants respectfully disagree.

Group II includes independent claim 44 and its dependent claims 45-50. Claim 44 recites a method for manufacturing a golf ball that includes providing the components of a composition, preparing the composition, and forming the composition into the golf ball. Any allegedly different process for manufacturing the golf ball including the composition of claim 1 would fall within the scope of claim 44, and thus, it cannot be considered materially different from the invention recited in claim 1. The claimed product, *i.e.*, the golf ball having the composition, cannot be made by a method other than that recited in claim 44, *i.e.*, a method of manufacturing the golf ball having the composition.

Moreover, Applicants respectfully request the Examiner to reconsider the restriction requirement between Group I and Group II for the reason that there is no additional burden to search and examine the two groups of claims together. Specifically, the claims of Group II describe a process for manufacturing a golf ball including the composition that is the subject of claim 1. The search and examination can proceed on the basis of claim 1. As such, there is no additional burden on the part of the U.S. Patent and Trademark Office to examine claims 1-43 together with claims 44-50. According to MPEP § 803, if the search and examination of patent claims can be made without serious burden, the Examiner must examine the patent claims on their merits, even though the application allegedly includes claims to independent or distinct inventions.

In addition to the above rule, the MPEP also provides for rejoinder of claims subject to a restriction requirement. According to MPEP § 821.04, non-elected process claims can be rejoined after an elected product claims is allowed if the process claims depend upon or otherwise include all of the limitations of the allowable product claim. This rule applies here. Therefore, claims 1-43 should be examined together with claims 44-50.

Appl. No. 10/662,626
Response dated September 20, 2004
Reply to Office Action of September 1, 2004

For the above reasons, Applicants respectfully request the withdrawal of the restriction requirement between Groups I and II.

Now, this application should be in condition for a favorable substantive examination. Early issuance of a Notice of Allowance is respectfully requested.

Respectfully submitted,
SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By: 

Brian D. Martin
Registration No. 47, 771

333 South Hope Street, 48th Floor
Los Angeles, California 90071
(213) 620-1780